

REMARKS

Applicants have thoroughly considered the Examiner's remarks in the March 02, 2007 Office action and have amended the application to more clearly set forth aspects of the invention. This Amendment A amends claims 1, 8, 15, and 18 and cancels claims 20 and 21.

Claims 1-19 are thus presented in the application for further examination. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

Drawings

Applicants respectfully request the Examiner to indicate whether the drawings submitted on January 21, 2004 have been accepted.

Claim Rejection Under 35 U.S.C. § 103

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, U.S. Pat. No: 7,130,887 in view of Olkin et al., U.S. Pat. No. 6,584,564. To establish a prima facie case of obviousness, the Office must demonstrate that every claim requirement is taught or suggested by the prior art.¹ Applicants respectfully submit that the cited references, alone or in combination, fail to teach or suggest each and every claim requirement as set forth in the independent claims.

Goldberg teaches creating and sending a first email message with CC or BCC recipients to all recipients. (Goldberg, FIG. 4, column 4, lines 11-12). Goldberg also teaches that a second email message, independent of the first email message, may be created and sent to CC and/or BCC recipients. (Goldberg, FIG. 4, column 4, lines 14-20). This second message is not the same as the first message and the sender must respond to a prompt and type in the second message. (Goldberg, FIG. 4, column 4, lines 14-22). Additionally, Goldberg teaches that if each CC/BCC recipient is to get separate individual messages, the user must type a message for each of the CC/BCC recipients. (Goldberg, FIG. 4, column 4, lines 11-22). Goldberg explains that the copy recipients receive an additional email message so the sender can add commentary, explanation, or clarification. (Goldberg, column 4, lines 16-20). Olkin et al. merely discloses the encryption of email messages using the public-key, and private-key based systems the encryption of an email message. (Olkin et al., column 2, lines 6-21).

¹ In re Royka, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974) (see also M.P.E.P. § 2143).

In contrast, claim 1, as amended, recites a method for protecting the identity of one or more hidden recipients of an email message, **the email message comprising an email header and an email body**, the method comprising:

- creating a first encrypted email body by encrypting the email body using a first encryption key;
- creating a second encrypted email body by encrypting the email body using a second encryption key;
- creating a **first encrypted email message**, said first encrypted email message **comprising a first email header referencing one or more revealed recipients**, said first encrypted email message **further comprising the first encrypted email body** and, for each of the one or more revealed recipients, an encrypted version of the first encryption key;
- creating a **second encrypted email message**, said second encrypted email message **comprising a second email header referencing one or more hidden recipients**, said second encrypted email message **further comprising the second encrypted email body** and, for each of the one or more hidden recipients, an encrypted version of the second encryption key;
- transmitting the first encrypted email message to the one or more revealed recipients referenced by the first email header; and**
- transmitting the second encrypted email message to the one or more hidden recipients referenced by the second email header.**

For example, an S/MIME message encrypted for a set of recipients can contain **information about those recipients (including the BCC recipients)** such as the recipientInfos field (see FIG. 4). (Specification, page 32, paragraph 79; FIG. 4). The recipientInfos field can provide recipient-specific information from which the identity of the recipients whose information is stored that field can be determined. (Specification, page 32, paragraph 79; FIG. 4). Therefore, **to avoid inadvertent disclosure of BCC recipients to those recipients listed in the TO and CC fields**, an encrypted message is created for only those recipients listed in the **TO and CC fields**, and a separate message encrypted for those recipients listed in the **BCC field**. (Specification, page 32, paragraph 79; steps 258 and 259 of FIG. 2). Therefore, the recipients listed in the TO and CC fields only receive messages that are encrypted for them, and which are not encrypted for any BCC recipients. (Specification, page 32, paragraph 79). Advantageously, even if one of the **TO and CC recipients** were able to access the **recipientInfos field**, it would only provide information about other recipients already listed in the TO and CC fields of the received email, and **it would not provide any information regarding any of the BCC recipients**. (Specification, page 32, paragraph 79).

Goldberg and Olkin et al., teach **sending the first message to all recipients (including the BCC recipients)** and while the names BCC recipients will not be seen in the body of the first message, the recipientInfos field in the header of the first message is the same for all recipients and **can provide recipient specific information from which the identity of the BCC recipients can be determined.** Thus, Applicants respectfully request reconsideration and withdrawal for the rejection of independent claim 1 because the cited art fails to teach each and every requirement of claim 1, such as "transmitting **the first encrypted email message to the one or more revealed recipients** referenced by the first email header; and **transmitting the second encrypted email message to the one or more hidden recipients** referenced by the second email header." Claims 2-7, which depend directly or indirectly from claim 1, are submitted as patentable for the same reasons as set forth above with respect to claim 1. Additionally, independent claims 8 and 15 have been similarly amended as claim 1 are submitted as patentable for the same reasons as set forth above with respect to claim 1. Claims 9-14 and 16-19 depend directly or indirectly from claims 8 and 15, respectively, and are submitted as patentable for the same reasons as set forth above with respect to claims 8 and 15.

Claim 15-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, and further in view of Olkin et al. and Price III U.S. Pat. No. 6,851,049. Price III teaches a recipient block for the email message that contains an entry for each recipient of the email message where each entry contains the session key encrypted with a public key associated with the recipient to form an encrypted session key, so that only a corresponding private key held by the recipient can be used to decrypt the encrypted session key. (Price III, column 2, line 21-29). However, Price III, alone or in combination with the other cited art, fails to teach each and every requirement of claim 15, including as "transmitting **the first encrypted email message to the one or more revealed recipients** referenced by the first email header; and **transmitting the second encrypted email message to the one or more hidden recipients** referenced by the second email header." Thus, Applicants respectfully request reconsideration and withdrawal for the rejection for claim 15. Claims 16-19 depend from claim 15 and are also submitted as patentable for the same reasons as set forth above with respect to claim 15.

Conclusion

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1-19 as presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

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